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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,470	02/23/2004	Koji Tajima	9683/168	1797

7590 07/16/2007  
Brinks Hofer Gilson & Lione  
NBC Tower, Suite 3600  
P.O. Box 10395  
Chicago, IL 60610

EXAMINER
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DEBNATH, SUMAN

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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07/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p align="center">10/784,470</p>	<p><b>Applicant(s)</b></p> <p align="center">TAJIMA ET AL.</p>	
	<p><b>Examiner</b></p> <p align="center">Suman Debnath</p>	<p><b>Art Unit</b></p> <p align="center">2135</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/24/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-7 are pending in this application.

#### ***Claim Objections***

2. Claims 1-2 and 5-7 are objected to for lack of antecedent basis:

Claim 1 recites "a communication terminal" in line 4 and line 6.

Claim 2 recites "a communication terminal" in line 4 and line 6.

Claim 5 recites "a communication terminal" in line 9.

Claim 6 recites "a communication terminal" in line 4 and line 6.

Claim 7 recites "a communication terminal" in line 4 and line 6.

Appropriate correction and/or clarification is required.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himeno (Pub. No.: US 2002/0138754 A1) and further in view of Grube et al. (Patent Number: 5,379,343) (hereinafter "Grube").

5. As to claim 1, Himeno discloses an electronic device comprising:

a storage ([0042], [0047]);

an obtaining unit for obtaining a first application that can be executed on said electronic device and an identifier, to store in said storage ([0042], [0046], "an ID extracting and verifying program is downloaded and installed");

a receiving unit for receiving from a communication terminal an identifier and a second application that can be executed only with said first application ([0047], "...the software program may be downloaded to the hard disk drive 12 together with the ID extracting and verifying program", [0050], Himeno teaches the concept of executing a second application only with first application by loading and executing the software program only after verifying the ID by ID extracting and verifying program ); and

a storing control unit for comparing said identifier received by said receiving unit with said identifier stored in said storage and, if both of said identifiers are identical, storing said second application in said storage ([0050], which describes if the provided ID is identical then the software program is loaded and executed), and if both of said identifiers are not identical, deleting said second application ([0050], "If not identical, the execution of the software program is inhibited").

Himeno doesn't explicitly disclose an identifier of a communication terminal. However, Grube discloses an identifier of a communication terminal (abstract, col. 3, lines 44-50 and col. 5, lines 15-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Himeno as taught by Grube in order to provide "a method which allows the detection of unauthorized use and

Art Unit: 2135

duplication of software applications and unit ID codes in communication units (Grube, col. 2, lines 40-45)".

6. As to claim 2, Himeno discloses an electronic device comprising:

a storage ([0042], [0047]);

an obtaining unit for obtaining a first application that can be executed on said electronic device and an identifier, to store in said storage ([0042], [0046], "an ID extracting and verifying program is downloaded and installed");

a first receiving unit for receiving an identifier from said communication terminal ([0047]);

a transmitting unit for comparing said identifier received by said first receiving unit with said identifier stored in said storage and, only if said identifiers are identical, transmitting a request to said communication terminal ([0042], [0047], [0050]); and

a second receiving unit for receiving from said communication terminal a second application that can be executed only with said first application ([0050]).

Himeno doesn't explicitly disclose an identifier of a communication terminal. However, Grube discloses an identifier of a communication terminal (abstract, col. 3, lines 44-50 and col. 5, lines 15-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Himeno as taught by Grube in order to provide "a method which allows the detection of unauthorized use and

Art Unit: 2135

duplication of software applications and unit ID codes in communication units (Grube, col. 2, lines 40-45)".

7. As to claim 4, Himeno discloses a communication terminal comprising:

a storage for storing an identifier ([0042], [0047]), a first application, and a second application that can be executed only with said first application ([0050]);

a transmitting unit for transmitting said identifier and said first application to an electronic device that is capable of executing said first application ([0047], [0050]);

a receiving unit for receiving an identifier from an electronic device ([0046]-[0050]);

a transfer controlling unit for comparing said identifier received by said receiving unit with said identifier stored in said storage and, only if said identifiers are identical, transmitting said second application to said electronic device ([0050]).

Himeno doesn't explicitly disclose an identifier of a communication terminal. However, Grube discloses an identifier of a communication terminal (abstract, col. 3, lines 44-50 and col. 5, lines 15-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Himeno as taught by Grube in order to provide "a method which allows the detection of unauthorized use and duplication of software applications and unit ID codes in communication units (Grube, col. 2, lines 40-45)".

Art Unit: 2135

8. As to claim 5, Himeno discloses a communication terminal comprising:
- a storage for storing an identifier ([0042], [0047]), a first application, and a second application that can be executed only with said first application ([0050]);
  - a transmitting unit for transmitting said identifier and said first application to an electronic device that is capable of executing said first application ([0047], [0050]);
  - a transfer controlling unit for receiving a message from a communication terminal and determining, on the basis of said message, whether to transmit said second application to said communication terminal ([0047], [0050]).

Himeno doesn't explicitly disclose an identifier of a communication terminal. However, Grube discloses an identifier of a communication terminal (abstract, col. 3, lines 44-50 and col. 5, lines 15-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Himeno as taught by Grube in order to provide "a method which allows the detection of unauthorized use and duplication of software applications and unit ID codes in communication units (Grube, col. 2, lines 40-45)".

9. As to claim 6, Himeno discloses a computer program product for causing a computer to execute the steps of:
- obtaining a first application that can be executed on said computer and an identifier to store in a storage of said computer ([0047], [0050]);

Art Unit: 2135

receiving from a communication terminal an identifier and a second application that can be executed only with said first application ([0046], [0047], [0050]); and

comparing said received identifier with said identifier stored in said storage and, if said identifiers are identical, storing said second application in said storage, and if said identifiers are not identical, deleting said second application ([0050]).

Himeno doesn't explicitly disclose an identifier of a communication terminal. However, Grube discloses an identifier of a communication terminal (abstract, col. 3, lines 44-50 and col. 5, lines 15-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Himeno as taught by Grube in order to provide "a method which allows the detection of unauthorized use and duplication of software applications and unit ID codes in communication units (Grube, col. 2, lines 40-45)".

10. As to claim 7, Himeno discloses a computer program product for causing a computer to execute the steps of:

obtaining a first application that can be executed on said computer and an identifier to store in a storage of said computer ([0046], [0047], [0050]);

receiving an identifier from said communication terminal ([0047]);

comparing said received identifier with said identifier stored in said storage and, only if said identifiers are identical, transmitting a request to said communication terminal ([0050]); and



Art Unit: 2135

receiving from said communication terminal a second application that can be executed only with said first application ([0047], [0050]).

Himeno doesn't explicitly disclose an identifier of a communication terminal. However, Grube discloses an identifier of a communication terminal (abstract, col. 3, lines 44-50 and col. 5, lines 15-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Himeno as taught by Grube in order to provide "a method which allows the detection of unauthorized use and duplication of software applications and unit ID codes in communication units (Grube, col. 2, lines 40-45)".

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Himeno and further in view of Grube and Dillard et al. (Pub. No.: US 2001/0014884 A1) (hereinafter "Dillard").

12. As to claim 3, neither Himeno nor Grube explicitly disclose wherein said electronic device is a car navigation device. However, Dillard discloses a car navigation device (abstract, [0026], lines 30-40, [0033] – [0035]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Himeno and Grube as taught by Dillard in order to "prevent unauthorized use of a database or other software transmitted over a communication link, such as internet (Dillard, [0009]).

Art Unit: 2135

13. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suman Debnath whose telephone number is 571 270 1256. The examiner can normally be reached on 8 am to 5 pm.

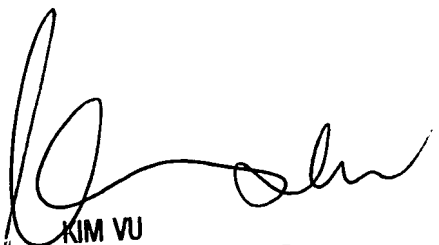
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 2135

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SD

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100